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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,369	08/24/2001	Lou Chauvin	83304AF-P	3908

7590 06/12/2006

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EXAMINER	
POLLACK, MELVIN H	

ART UNIT	PAPER NUMBER
2145	

DATE MAILED: 06/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/939,369	CHAUVIN ET AL.	
	Examiner	Art Unit	
	Melvin H. Pollack	2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 March 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *05 November 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: *see attached office action*.

DETAILED ACTION

New Examiner

1. This case has been assigned to a new examiner. The contact information will be given in the conclusion section of this action.

Response to Arguments

2. Applicant's arguments filed 17 March 2006 have been fully considered but they are not persuasive. An analysis of the arguments is provided below.

3. Applicant argues that Smart does not expressly disclose automatically providing the requestor with a list... based on criterion," stating that "the device determines if its own criterion are compatible (P. 9, lines 28-29)." The examiner has determined that devices outside the camera, i.e. a printer 106, automatically determines whether there are compatibility issues, and if so, if there are other available replacement services (Smart, Paras. 117-120). This, in light of the selection criteria information previously mentioned (Paras. 115-116 and Table 1) is sufficient to show this limitation.

4. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a device other than the device utilized by a requestor must provide the requestor with a list (Pp. 9-10)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

5. In response to applicant's argument that the invention uses business criterion rather than compatibility criterion, a recitation of the intended use of the claimed invention must result in a

structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

6. In light of the amendment, the examiner will modify the original art rejection in order to provide case law regarding the patentability of business criterion over compatibility criterion, and to provide further clarification of the claim 6 arguments.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smart et al. (US 2003/0208691).

9. For claims 1, 21, and 22, Smart teaches a method and system (abstract) of linking a digital photographic imaging service requester to a service provider selected from a plurality of different service providers (Paras. 1-11) comprising:

a. Providing a services directory which includes entries for a plurality of services, each service associated with at least one of said plurality of different service providers (Para. 53; a service directory comprising a plurality of services where each service can discover information about other services);

b. Selecting of a service by the service requester to be provided with respect to a digital image (Paras. 77-78 and 175; user selects the services pertaining to a camera, to access pictures or print out photos at a remote print shop service);

c. Automatically providing the requester with a list of one or more of said plurality of different service providers based on a criterion (Paras. 115-120 and Table 1; manually selectable criteria, and the directory services comprising a list of available services);

d. Said requester selecting one of said plurality of different service providers from said list (Paras. 77, 78, 116, 170 and Table 1; user selects services through command string or program to perform the set of desired services and/or actions, i.e. printing images via print shop service);

e. Providing a request for a desired service to the selected service provider (Fig. 15, #508; Para. 127; request to print image, forwarded to print shop service); and

f. Providing of said desired service by said selected service provider (Para. 170; image printed at print shop service).

10. Smart does not teach the specific form of criterion being business related, recited in the claimed invention. However, the specific meaning/interpretation of the criterion utilized by the system does not patentably distinguish the claimed system. Further, the recited statement of intended use, to filter the list of service providers based on business criterion rather than compatibility criterion, does not patentably distinguish the claimed system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide any type of criterion in the system taught by Smart because the subjective interpretation of the criterion

does not patentably distinguish the claimed invention; a network system. *See In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

11. For claim 2, Smart teaches that the criterion comprises a location of a designated recipient (Paras. 95-101; physical location, supported commands, etc. of the service can offer).

12. For claim 3, the criterion is selected from one of the following: Brand, Cost of Service, Specific Product Characteristics, Delivery Time, Delivery method, Delivery reach, Specific provider characteristics, Access time, and Ability to ship to a specific location (Paras. 95-101).

13. For claim 4, Smart teaches that said automatically providing of said list is accomplished through the use of a locator service (Para. 53).

14. For claim 5, Smart teaches that said criterion is a dynamic criterion (Paras. 53 and 95-101; criterion changes based on client's needs on resolution of the print job and supported image formats).

15. For claim 6, Smart does not expressly disclose that said dynamic criterion comprises price. Examiner takes Official Notice (see MPEP § 2144.03) that "sorting by price" in a computer networking environment was well known in the art at the time the invention was made. Utilizing the value and prices of services is well known in the art and routinely used for agreeing for types of services offered, acting as a binding agreement between purchaser and provider. It would have been obvious to one of ordinary skill in the art to include dynamic criterion comprising price with Smart because it would provide for an electronic commerce environment, by allowing for price agreement for a particular service.

16. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03. However, MPEP § 2144.03 further states "See also In re Boon, 439 F.2d

724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, In re Boon, 169 USPQ 231, 234 states "as we held in Ahlert, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

17. For claim 7, Smart teaches that said dynamic criterion is set for a predetermined period of time (Table 1; print job's expected time of completion).

18. For claim 8, Smart teaches that said dynamic criterion comprises the work flow capacity of the provider (Paras. 95-101; amount/types of resolution supported by the service, available images, and supported formats all have a direct effect on the work flow or the types of work or instances of work the provider can support. For example, a low image printer on the provider side can not support high quality image print outs, thus restricting the work flow capacity of the provider.)

19. For claim 9, Smart teaches that said dynamic criterion is automatically adjusted based on predetermined criterion (Para. 116 and Table 1; criteria predetermined based on user's sample selection, i.e. print quality or image formats; said parameter values can be changed dynamically based on predetermined user desired photo quality).

20. For claim 10, Smart teaches that said requester selecting one of said plurality of different service providers from said list further comprises obtaining a subset of providers from said list based on a second criterion (Fig. 20, #2012 and #2014; Para. 127; printer is unable to process the user's request, thus a remote 3rd party printer's services is solicited, resulting in processing of the print job on said first printer's behalf).

21. For claim 11, Smart teaches that said criterion is directly associated with the digital image (Paras. 95-101 and Table 1; association in terms of photo quality).

22. For claim 12, Smart teaches that said second criterion comprises one of the following: least expensive or closest (Para. 97 and Table 1; I/O matching).

23. For claim 13, Smart teaches that the service provider is positioned on the display screen of imaging client according to a business criteria (Para. 170; business criteria comprises at least one of a plurality of printer services located across the network, said services displayed to and selected by the user). See also claim 1 discussion above.

24. For claim 14, Smart does not expressly disclose that said business criteria is based on the amount paid by the service provider to be on said service directory. Examiner takes Official Notice (see MPEP § 2144.03) that "amounts paid to be in a directory" in a computer networking environment was well known in the art at the time the invention was made. It is also routinely used as a criteria prior to offering such a directory service. It would have been obvious to one of ordinary skill in the art to include fee based directory services in Smart in order to provide for an electronic commerce environment, by allowing for a fee based directory service to provide for additional revenue.

25. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03. However, MPEP § 2144.03 further states "See also In re Boon, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, In re Boon, 169 USPQ 231, 234 states "as we held in Ahlert, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

26. For claim 15, Smart does not expressly disclose that said business criteria is based on a contract. Examiner takes Official Notice (see MPEP § 2144.03) that "contracts between business parties" in a computer networking environment was well known in the art at the time the invention was made. Such contracts are routinely used between service provider and service recipient acting as a binding agreement between the two parties. It would have been obvious to one of ordinary skill in the art to include a contract with Smart in order to provide for a binding agreement between two parties within an electronic commerce system, by allowing for a form of agreement to perform fair business practices.

27. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03. However, MPEP § 2144.03 further states "See also In re Boon, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain

adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, In re Boon, 169 USPQ 231, 234 states "as we held in Ahlert, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

28. For claim 16, Smart teaches that said business criteria is based on the image capture device (Figs. 1 and 2; image capturing device is a digital camera, from which clients can view images; Para. 170; camera provides the print shop service with desired service specifications and characteristics during the profile matching process).

29. For claim 17, Smart teaches that said image capture device comprises a digital camera (Fig. 2, #102).

30. For claim 18, Smart teaches that Said image capture device is programmed at the time of purchase (digital cameras are inherently pre-configured to have software running within the camera, i.e. software menus and interfacing drivers).

31. For claim 19, Smart teaches that a kiosk is used to access the service provider (Paras. 42 and 45-47; Fig. 1, #1702; Fig. 21, #2100).

32. For claim 20, Smart teaches a system (abstract) for providing imaging services over a communications network (Paras. 1-11), including:

a. A first device having a user interface for receiving commands from a user and a network interface (Figs. 1 and 2; Para. 42; user contacts the directory service through the terminal, functions are interpreted and/or implemented using software, such as an application program, executing within the device and configured where appropriate to communicate with other devices in the system);

b. A plurality of different service providers connected to said communication network (Fig. 2, #104 and #106; service providers have printer services for digital photographs);

c. A computer having a network interface for communication to said first device over said communication network, wherein said computer having a services directory having entries for a plurality of services, at least one service is associated with said plurality of different service providers, each of said plurality of different service providers having associated information (Para. 53; a service directory comprising a plurality of services where each service can discover information about other services, high resolution printer service offers different information than low resolution printer service);

d. Wherein the user, using first device, selects a service (Paras. 77-78 and 175; user selects the services pertaining to a camera, to access pictures or print out photos at a remote print shop service);

e. Said computer automatically provides a list of at least one of said plurality of different service providers based on a criterion using said associated information (Paras.

115-120 and Table 1; manually selectable criteria, and the directory services comprising a list of available services);

f. Said selected service provider providing said requested service (Para. 170; image printed at print shop service).

33. Smart does not teach the specific form of criterion being business related, recited in the claimed invention. However, the specific meaning/interpretation of the criterion utilized by the system does not patentably distinguish the claimed system. Further, the recited statement of intended use, to filter the list of service providers based on business criterion rather than compatibility criterion, does not patentably distinguish the claimed system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide any type of criterion in the system taught by Smart because the subjective interpretation of the criterion does not patentably distinguish the claimed invention; a network system. *See In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

Conclusion

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H. Pollack whose telephone number is (571) 272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MHP
07 June 2006

JASON CARDONE
SUPERVISORY PATENT EXAMINER